



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

#17

United States Receiving Office  
United States International Searching Authority  
United States International Preliminary Examining Authority  
United States Designated Office  
United States Elected Office

Address: Commissioner of Patents and Trademarks  
Box PCT  
Washington, D.C. 20231

22 NOV 1994

Benton S. Duffett  
Burns, Doane, Swecker & Mathis  
George Mason Building  
Washington and Prince Streets  
P.O. Box 1404  
Alexandria, Virginia 22313-1404

In re Application of :  
HOFVANDER et al : DECISION ON  
Application No.: 08/070,455 :  
PCT No.: PCT/SE91/00892 : PETITION  
Int. Filing Date: 20 December 1991 :  
Priority Date: 21 December 1990 : UNDER 37 CFR 1.42  
For: GENETICALLY ENGINEERED :  
MODIFICATION OF POTATO TO FORM : AND 1.44  
AMYLOPECTIN-TYPE STARCH :

This decision is in response to the "SUBMISSION PURSUANT TO 37 CFR 1.42 AND 1.44" filed November 24, 1993.

BACKGROUND

On 20 December 1991, applicants filed international application PCT/SE91/00892, which claimed priority of an earlier Swedish application filed 21 December 1990. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 20 July 1992. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 May 1992. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 21 July 1993.

On 09 June 1993, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application as required by 35 U.S.C. 371(c)(2); and a declaration of three of the four inventors and by

604

271

Lennart Hansson for the deceased inventor Anneli Tallberg.

On 13 September 1993, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903).

On 24 November 1994 applicants filed the following papers:

1) a declaration signed by three of the four inventors. The declaration indicated that the heirs of Anneli Tallberg are Maria Torper, surviving daughter who is of age, and Olof Torper, underage surviving son. The declaration was also signed by Maria Torper and Tommy Tallberg as guardian of Olof Torper.

2) a certified copy of the estate inventory of the property of Anneli Tallberg and what is purported to be a translation thereof.

3) a certified copy from the Guardianship Book of the Lund District Court showing that Tommy Tallberg is the legal guardian of Olof Torper and a translation thereof;

#### DISCUSSION

The declaration submitted on 09 June 1993 was not in compliance with 37 CFR 1.63 because it did not identify Lennart Hansson as the legal representative of Anneli Tallberg. Accordingly, the Notification of Acceptance was mailed in error and is hereby VACATED.

The estate inventory appears to be incomplete as it does not have a copy of the will attached as stated on the first page. The translation of the estate inventory appears to be incomplete because it does not appear that pages 2-4 have been translated. It is not entirely clear that the sole heirs are Maria Torper and Olof Torper.

Applicants should present a legal memorandum executed by an attorney verifying that he is familiar with the law (heirs and legal representation thereof) of Sweden; the names of the persons authorized to act on behalf of the deceased joint inventor, under current Swedish law; and the status of current Swedish law by providing a copy of the applicable law of the relevant portions, including any necessary English translation, showing that under the laws of Sweden the so-named persons have the full power to carry out transactions of the estate.

The legal memorandum may be either (1) in declaration form (e.g. 37 CFR 1.68) or (2) notarized and have either the signature of the Notary authorized by a consular officer or use an apostille.

Accordingly, applicants have not satisfied the proof of authority required by 37 CFR 1.44.

605

014

The \$130 surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) has been charged to counsel's Deposit Account No. 02-4800.

CONCLUSION

The above application and papers have been reviewed and have been found in compliance with 37 CFR 1.42.

The papers filed under 37 CFR 1.42 are ACCEPTED.

It is noted that proof of authority of the legal representative in compliance with 37 CFR 1.44 MUST be submitted before the grant of a patent.

The application must be returned to the Legal Affairs Branch of the Office of Administrator of Legal Affairs after mailing any "Notice of Allowability" or "Notice of Allowance and Issue Fee Due" for review of the proof of authority of the legal representative. The application is being forwarded to the National Stage Processing Division for preparation and mailing of a corrected Notice of Acceptance indicating a 35 U.S.C. 371(c) date and 102(e) date of **24 November 1993**. The application will then be forwarded to the Application Processing Division for the mailing of a corrected filing receipt including an indication that Maria Torper and Olof Torper have filed on behalf of the deceased inventor Anneli Tallberg.



Leonard E. Smith  
Legal Examiner  
Legal Affairs Branch



Conferee: Richard B. Lazarus  
Supervisory Legal Examiner  
Legal Affairs Branch

LES/RBL:ls

606

017